

REMARKS

The present amendment is responsive to the Office Action of February 27, 2004. The fee for a three-month extension of time is included in the form PTO-2038 submitted herewith.

Applicants affirm the election of Group 1, claims 69-77, without traverse.

Claims 69-77 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,440,147 and over claims 1-19 of U.S. Patent No. 6,689,145.

Responsive thereto, submitted herewith is a first terminal disclaimer over commonly assigned U.S. Patent No. 6,440,147 and a second terminal disclaimer over commonly assigned U.S. Patent No. 6,689,145.

Reconsideration and withdrawal of the obviousness-type double patenting rejection of claims 69-77 are, therefore, respectfully requested.

As the Examiner will note, the subject matter of claim 70 has been incorporated into independent claim 1. Claim 70 has been cancelled.

Claims 69-77 were rejected under 35 USC §102(e) as being anticipated by McGuckin, Jr. et al., U.S. Patent Nos. 4,280,450 and 6,626,903. Reconsideration and withdrawal of these rejections are respectfully requested.

At the outset, the Examiner will note that the McGuckin, Jr. et al. U.S. Patent No. 6,626,903 (hereafter, McGuckin 2) is a continuation-in-part of the 09/122,185 application that matured into the applied U.S. Patent No. 6,280,450 McGuckin, Jr. et al. patent (hereafter, McGuckin 1). McGuckin 2 was filed on April 27, 2001, which filing date is after the filing date of the priority date

of the present application. Indeed, the present application is a continuation of commonly assigned application filed on May 4, 2000, now U.S. Patent No. 6,440,147 and enjoys its effective filing date for §102 purposes. Therefore, none of the new disclosure added to McGuckin 1 to form McGuckin 2 can be prior art to the present application, as any material in McGuckin 2 not present in McGuckin 1 necessarily enjoys a filing date no earlier than April 27, 2001. McGuckin 2, U.S. Patent No. 6,626,903, is not prior art to the present application.

Turning now to McGuckin 1, the Examiner will note that the apparatus disclosed therein requires that the membrane tissue containment bag 216 be expanded to surround the cut tissue. Then, drawstrings 218 are pulled to close the margin 217 of the bag 216. The expandable sheath 230 is then advanced about the tissue containment bag 216. Thereafter, the tissue containment bag 216 is pulled at least partially within the support conduit 202 while squashing (McGuckin's term) the tissue mass 228 into a longitudinally elongated form. Thereafter, the bag 216 and contained tissue mass may be removed from the sub-cutaneous tissue. See Col. 9, line 40 to Col. 8, line 29 of McGuckin 1.

As described above and as shown in Figs. 13-20 of McGuckin 1, both the bag 216 and the expandable sheath start from an initial retracted configuration (see retracted bag 216 in Fig. 13 and retracted expandable sheath 230 in Fig. 16) to an expanded configuration (see expanded bag 216 in Fig. 15 and expanded sheath 230 in Fig. 19) to contain tissue mass 228. Thereafter, as shown in Figs. 19 and 20, the bag 216 (still in the expanded configuration) is drawn into the expandable portion 231 of the sheath 230 and into the interior of support conduit 202. See Col. 8, lines 19-29. Never are the bag 216 and the sheath 230 returned to their retracted configuration prior to or during the step of removing the device from the sub-cutaneous tissue.

In contrast, the embodiment defined by amended claim 1 recites the steps of:

encapsulating the cut specimen with the thin flexible membrane while maintaining the cut specimen intact and isolating the captured specimen from contact with the surrounding breast tissue and returning the tissue collection element to the retracted position while maintaining the cut specimen intact and encapsulated;

removing the device from the breast tissue while the specimen remains encapsulated within the thin flexible membrane of the retracted tissue collection element.

McGuckin 1 does not teach or suggest returning either the bag 216 or the sheath 230 to a retracted position while maintaining the cut specimen intact and encapsulated, nor does McGuckin teach or suggest removing the device from the breast tissue with the bag 216 or sheath 230 in the retracted position, as required by amended independent claim 1 and its dependent claims.

It is respectfully submitted that if the bag 216 and/or the sheath 230 were to be returned to the retracted position (the feasibility of which the undersigned has no opinion), McGuckin's cut breast tissue could not remain encapsulated within the bag 216 and/or the sheath 230. Indeed, carrying out a step of returning the sheath 230 and/or the bag 216 to the retracted position prior to removing McGuckin's device would free the cut specimen, making the removal thereof impossible. In other words, McGuckin's specimen cannot be removed if the bag 216 and/or the sheath 230 are returned to the retracted position. In contrast, only the claimed method allows removal of a specimen encapsulated within a thin flexible that has been returned to the retracted position. McGuckin 1, therefore, does not teach or suggest the method of removing a specimen of breast tissue of claim 1 and its dependent claims. It is believed, therefore, that the 35 USC §102(e) rejection applied to claims 69-77 is not tenable and should be withdrawn. The same is, therefore, respectfully requested.

The present application is now believed to be in condition for allowance. Should the Examiner have any questions, the Examiner has but to contact the undersigned attorney of record at the telephone number indicated below and whatever is required will be done immediately.

Respectfully submitted,

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By: 

Alan W. Young
Attorney for Applicants
Registration No. 37,970

YOUNG LAW FIRM, P.C.
4370 Alpine Rd., Ste. 106
Portola Valley, CA 94028
Tel.: (650) 851-7210
Fax: (650) 851-7232

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